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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/044,348	DUREAU, VINCENT
	Examiner	Art Unit	
	Justin E. Shepard	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>15 October 2007</u>.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-10 and 12-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-10 and 12-29</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/15/07 have been fully considered but they are not

persuasive.

Page 8, last paragraph:

The applicant argues that Kaars does not disclose a device wherein the

transcoder subsystem is configured to detect a communication from a secondary

device. Specifically that Kaars teaches that a user inputs a model number of the

secondary device into the transcoder subsystem to determine which transcoding

protocol to use (paragraph 28). Kaars teaches that the user interface could be

implanted on a television (or other display), which referring to figure 1 would be an

external device (part 120) to the transcoding subsystem (100).

The applicant also argues that the transcoder subsystem does not automatically

retrieve the transcoder subunit from an external entity. Please refer to the objection

below for an explanation.

Page 9, paragraph beginning with "Further":

The applicant argues that there is no teaching in Plourde to suggest disregarding

the secondary data upon determining the first data is not compatible with a secondary

device. As Kaars discloses a device wherein if there is not enough space on the

device, the data will be disregarded (figure 2B, part 212), and Plourde teaches a device

wherein the downloading of the content is not allowed if the bit-rate is too high (and

therefore the resulting file would be too large). This combination meets the limitation presented in the claim.

Page 10, first paragraph:

      The applicant argues that the addition of Moroney does not meet the limitation of claim 12. As Moroney teaches a device wherein a first request (user inputting the quality level), which communicates to the storage device the codec at which to store the resulting program without communicating what specific codec to use (only gives a broad descriptor, and not the specifics e.g. MPEG2 at 700kbps), this is seen as meeting the limitation.

Claim Objections

      Claims 1, 13 and 20 are objected to because of the following informalities: The term "automatically" which refers to the retrieving of data is not a detailed enough description. This is especially clear in the applicant's arguments, as Kaars discloses a device where the new transcoding codecs can be downloaded by the system (without user interaction, e.g. the user surfing the web and downloading and installing the codec manually), which seems to be automatic. As the applicant disagrees with this interpretation, the examiner suggests that applicant add language to the claim to better explain this limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1.   Claims 1, 2, 3, 4, 5, 13, 20, 28, and 29 are rejected under 35 U.S.C. 102(e) as

being anticipated by Kaars.

Referring to claim 1, Kaars discloses a client for use in a television system,

wherein the client is located in a television viewer home (figure 1) and comprises:

a receiver configured to receive a programming signal (figure 1);

an interface configured to communicate with a secondary device external to the

client (figure 1, parts 104 and 150); and

a transcode subsystem coupled to the receiver and the interface (paragraph 21),

wherein the transcode subsystem is configured to:

detect a communication from the secondary device (paragraph 29);

determine a target data format corresponding to the secondary device

(paragraph 28);

convey a request to an external entity for a transcode subunit corresponding to

said target data format, in response to determining the transcode subsystem is not

configured to support said target data format (paragraphs 28 and 35);

automatically retrieve the transcode subunit from an external entity, responsive to the request (paragraph 35);

receive data targeted to the secondary device, wherein the received data comprises a first data format (figure 2A; part 200);

determine whether the first data format is compatible with the secondary device (paragraph 28);

identify the transcode subunit as corresponding to both the first data format and the target data format, in response to determining the first data format is not compatible with the secondary device (paragraph 28); and

initiate transcoding of the received data from the first data format to the target data format using the transcode subunit (figure 2B; parts 214 and 216).

Claims 13 and 20 are rejected on the same grounds as claim 1.

Referring to claim 2, Kaars discloses a client of claim 1, wherein the transcode subsystem includes a config table configured to associate the secondary device with the target data format (figure 2A, parts 208).

Referring to claim 3, Kaars discloses a client of claim 1, wherein the transcode subsystem comprises a control unit configured to access the config table to determine the target data format, and wherein the transcode subsystem is further configured to register the secondary device in response to determining the transcode subsystem is configured to support said target data format (paragraph 28).

Referring to claim 4, Kaars discloses a client of claim 1, wherein the transcode subsystem comprises a transcode subunit configured to perform the transcoding (paragraph 28; Note: as the transcoding is performed by software stored in memory, the examiner is interpreting each piece of transcoding software as a transcode subunit).

Referring to claim 5, Kaars discloses a client of claim 4, wherein the transcode subsystem further comprises a second transcode subunit configured to transcode data to a second data format (paragraph 28).

Referring to claim 28, Kaars discloses a client as recited in claim 1, wherein the transcode subsystem is configured to store a plurality of transcode subunits, each of which transcodes data from one format to a different format (paragraph 28).

Referring to claim 29, Kaars discloses a client as recited in claim 1, wherein said secondary device is selected from the group consisting of: a television, personal digital assistant, video monitor, video camera, electronic tablet, audio speakers, audio receiver, cell phone, game console, web based server, and a remote control (paragraph 25)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 6, 7, 14, 15, 16, 21, 22, 23, and 25 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Kaars in view of Krapf.

Referring to claim 6, Kaars does not disclose a client of claim 2, wherein the

transcode subsystem is configured to: detect an additional secondary device; and

register the additional secondary device.

In an analogous art, Krapf teaches a client of claim 2, wherein the transcode

subsystem is configured to: detect an additional secondary device; and register the

additional secondary device.

At the time of the invention it would have been obvious for one of ordinary skill in

the art to register the device as taught by Krapf in the system disclosed by Kaars. The

motivation would have been to enable the STB to determine what content is stored on

the device (Krapf: column 6, lines 61-67).

Claims 15 and 22 are rejected on the same grounds as claim 6.

Referring to claim 7, Kaars discloses a client of claim 6, wherein registering the

additional secondary device comprises storing an entry corresponding to the secondary

device in the config table, wherein the entry indicates the corresponding target data
format (paragraphs 28 and 35).

Claims 16 and 23 are rejected on the same grounds as claim 7.

Claims 14, 21, and 25 are rejected on the same grounds as claims 6 and 7.

3.   Claims 8, 17, 24, and 26 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Kaars in view of Plourde.

Referring to claim 8, Kaars does not disclose a client as recited in claim 1,
wherein the transcode subsystem is configured to:

discard the second received data in response to determining the first data format
is not compatible with the secondary device, and determining no transcode subunit
corresponding to both the first data format and the target data format is available.

In an analogous art, Plourde teaches a client as recited in claim 1, wherein the
transcode subsystem is configured to:

discard the second received data in response to determining the first data format
is not compatible with the secondary device, and determining no transcode subunit
corresponding to both the first data format and the target data format is available (page
14, paragraph 107, lines 22-24).

At the time of the invention it would have been obvious for one of ordinary skill in
the art to add the method of determining that no transcode subunit is available, as
taught by Plourde, to the system disclosed by Kaars. The motivation would have been

to stop large bit-rate files from being downloaded and using up the storage space

(Plourde: page 14, paragraph 107, lines 24-27).

Claims 17, 24, and 26 are rejected on the same grounds as claim 8.

4.   Claims 9, 10, 18, 19, and 27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kaars in view of Chatani.

Referring to claim 9, Kaars does not disclose a client of claim 1, wherein the

transcode subunit is further configured to display an indication to a viewer as to where

the transcode subunit may be obtained, in response to determining said transcode

subunit is not automatically retrievable.

In an analogous art, Chatani teaches a client of claim 1, wherein the transcode

subunit is further configured to display an indication to a viewer as to where the

transcode subunit may be obtained, in response to determining said transcode subunit

is not automatically retrievable (page 7, column 2, lines 14-17).

At the time of the invention it would have been obvious for one of ordinary skill in

the art to add the website software purchasing taught by Chatani to the system

disclosed by Kaars. The motivation would have been to make it simple for users to

upgrade their STB with software developed by users (Kaars: paragraph 35).

Claim 18 is rejected on the same grounds as claim 9.

Referring to claim 10, Kaars does not disclose a client of claim 9, wherein said

indication comprises a message selected from the group consisting of: a location where

the requested subunit may be purchased; and a link to a website where the requested

subunit may be obtained.

In an analogous art, Chatani teaches a client of claim 9, wherein said indication

comprises a message selected from the group consisting of: a location where the

requested subunit may be purchased; and a link to a website where the requested

subunit may be obtained (page 7, column 2, lines 14-17).

At the time of the invention it would have been obvious for one of ordinary skill in

the art to add the website software purchasing taught by Chatani to the system

disclosed by Kaars. The motivation would have been to make it simple for users to

upgrade their STB with software developed by users (Kaars: paragraph 35).

Claim 19 is rejected on the same grounds as claim 10.

Claim 27 is rejected on the same grounds as claims 9 and 10.

5.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaars in

view of Moroney.

Referring to claim 12, Kaars does not disclose a client of claim 1, wherein the

client is further configured to: receive a first request from the secondary device for

remote data; and generate a second request corresponding to said first request,

wherein said second request does not include an indication of a data format required by

said secondary device.

In an analogous art, Moroney teaches a client of claim 1, wherein the client is

further configured to: receive a first request from the secondary device for remote data;

and generate a second request corresponding to said first request, wherein said second request does not include an indication of a data format required by said secondary device (column 8, lines 19-22).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the user inputted transcoding settings taught by Moroney to the system disclosed by Kaars. The motivation would have been to allow the user to store a lower resolution copy when available storage space was running low, therefore preserving the remaining space.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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